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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,863	06/19/2000	Istvan Novak	5181-62800	7061

7590 11/15/2002  
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EXAMINER

BETTENDORF, JUSTIN P

ART UNIT PAPER NUMBER

2817

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/596,863	NOVAK, ISTVAN	
	Examiner	Art Unit	
	Justin P. Bettendorf	2817	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-35 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-15 and 17-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al. U.S. Patent No. 6,198,362 in view of Roy et al. "ESR and ESL of Ceramic Capacitor Applied to Decoupling Applications" (cited by the applicant as B19) and Novak "Reducing Simultaneous Switching Noise and EMI on Ground/Power Planes by Dissipative Edge Termination" (cited by the applicant as B15) {all of record, for reasons of record}.

It should be noted with respect to the newly added limitations of claims 8 and 17 (i.e., less than or equal to the inductance of the electrical power distribution structure  $L_p$ ) that the  $L_p$  is defined as  $\mu_o \bullet h$ ; therefore, the rejections based on the mounted inductance being less than  $0.2 \bullet n \bullet \mu_o \bullet h$  also apply.

### *Response to Arguments*

2. Applicant's arguments filed 7/24/02 have been fully considered but they are not persuasive.

The applicant argues that the mounted inductance being less than or equal to the  $L_p$  is not inherent.

Art Unit: 2817

This argument is not persuasive because it is the inherent property of the capacitor mounted on the board, which is the basis for determining the mounted inductance (i.e. that is the meaning of the adjective "mounted"). The inherency of the mounted inductance being less than or equal to the  $L_p$  or  $0.2 \bullet n \bullet \mu_o \bullet h$  is based on the fact that the Harada et al. reference discloses that the undesired wave radiated from the power supply is suppressed, which is the requirement for the value of the mounted inductance (col. 7, lines col. 50-65 and figure 6). That is, the undesired electromagnetic wave would not be suppressed unless the mounted inductance is less than the limit recited in the claim. As noted in MPEP 2112, the express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir.1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Furthermore, MPEP 2112 states "once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference".

***Allowable Subject Matter***

3. Claims 31-35 are allowed.

Art Unit: 2817

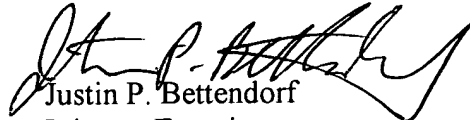
4. The following is a statement of reasons for the indication of allowable subject matter:

None of the cited references teaches a method involving making a determination of two different number of capacitors based on whether plane resonances are to be suppressed or not as recited in independent claim 31.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin P. Bettendorf whose telephone number is (703) 308-2780. The examiner can normally be reached on 6:00-3:30 (M-F, 1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on (703) 308-4909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Justin P. Bettendorf  
Primary Examiner  
Art Unit 2817

jpb  
November 12, 2002